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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
PSTM0020/MRK

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on June 13, 2006

Signature Alexandra Allison

Typed or printed name Alexandra Allison

Application Number	Filed
09/685,077	10/6/2000
First Named Inventor: Bilibin, Paul	
Art Unit: 3629	Examiner: Webb, Jamisue A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 45744
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____

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June 13, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of forms are submitted.

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Alexandra Allison

OIPE IAP41 JUN 15 2006 PATENT & TRADEMARK OFFICE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Paul Bilibin, et al.
Application No.	:	09/685,077
Filed	:	October 6, 2000
Title	:	APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT DETERMINATION OF RATABLE WEIGHT FOR MULTIPLE CARRIERS
Grp./Div.	:	3629
Examiner	:	Webb, Jamisue A.
Docket No.	:	PSTM0020/MRK

PRE-APPEAL BRIEF REQUEST FOR REVIEW REASONS

Mail Stop AF
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140 S. Lake Ave., Suite 312
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June 13, 2006

Commissioner:

In the Office Action dated March 13, 2006, a Final rejection, Claims 1-5, 58, 59, 70 and 72 were rejected under 35 USC § 102(b) as being anticipated by Nicholls et al. (U.S. Patent No. 5,485,369; "*Nicholls*"); Claims 7, 71, 73, 78, and 83 were rejected under 35 USC § 103(a) as being unpatentable over *Nicholls* in view of Kara (U.S. Patent No. 6,233,568; "*Kara*"); Claims 6 and 60-61 were rejected under 35 USC § 103(a) as being unpatentable over *Nicholls* in view of Barns-Slavin et al. (U.S. Patent No. 5,995,950; "*Barns-Slavin*"); and Claims 62, 66, 74 and 79 were rejected under 35 USC § 103(a) as being unpatentable over *Nicholls* in view of Jensen, U.S. Patent No. 5,331,118 ("*Jensen*"). Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 may sometimes be referred to herein collectively, as the "rejected Claims."

After carefully considering the rejections, a pre-appeal brief panel review of the rejection of the rejected Claims is respectfully requested on grounds described in more detail below with reference to the Claims of the present application as amended in the Amendment and Response filed in response to the Office Action dated November 17, 2005 (the "*Amendment and Response*").

A. NO SHOWING UNDER MPEP §2143 FOR EACH LIMITATION OF EACH CLAIM

It is respectfully asserted that the rejections did not indicate, as required under MPEP §2143, how the cited references, even when combined, disclose, anticipate, teach or suggest *each*

of the limitations of each of the rejected Claims. For example, it is respectfully submitted that the rejections did not indicate, as required under MPEP §2143, how the cited references disclose, anticipate, teach or suggest the following limitations recited by Claim 1:

> ... in response to [a] first input [comprising a first set of parcel specifications for a first parcel]: ... apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel ....

It is respectfully submitted that there is no explicit disclosure in *Nicholls* that *Nicholls* calculates a dimensional weight. In lieu of any explicit disclosure in *Nicholls* of a calculation of dimensional weight, the Office Action cites columns 21 and 22, line 65 of *Nicholls* as supporting the proposition that "...Nicholls ... determines a dimensional weight ...". The citation is directed to one of many entries in "Table II". The cited entry in "Table II" is identified as an "I/O Token" named "DIMWT" and is described as "dimensional weight".

For the reasons described further below, it is respectfully submitted that the appearance of the cited "DIMWT" I/O Token entry in "Table II" of *Nicholls* does not constitute a disclosure that "DIMWT" is a value that has been "calculated" by *Nicholls* as recited by, *e.g.,* Claim 1, or that the I/O Token named "DIMWT" is necessarily even populated by *Nicholls*.

Nicholls explains that "[t]he presently preferred embodiment uses a tokenized message passing scheme in which all data is passed back and forth between client and server as ordered pairs of tokens and associated data values.... Table II ...[presents] a sample listing of tokens ..." *Nicholls*, col. 12, line 62 - col. 13, line 1. *Nicholls* also explains that "[i]n order to allow the client server logistics management system to communicate with the outside world, e.g. with external data bases or other application programs, the external processing manager is provided." *Nicholls*, col. 13, lines 39 - 42. In view of the above-outlined disclosure of *Nicholls*, it is respectfully submitted that the presence of an entry in Table II of *Nicholls* is therefore merely a sample listing of a token and does not constitute a disclosure that the entry is necessarily populated by *Nicholls*.

Further, even assuming that *Nicholls*, at some point, populates a "DIMWT" I/O Token, there is no disclosure, teaching or suggestion that *Nicholls* would do so "for each respective carrier of a plurality of carriers" as recited, *e.g.,* by Claim 1. Rather, it is respectfully submitted

that there is only a single "DIMWT" entry in Table II of *Nicholls*. Further, the single "DIMWT" entry follows a long list of per-package entries describing customer/user-specified input for the particular package, including, among others, *e.g.*, weight, package length, package width, package height, recipient ID, recipient contact name, recipient company name, etc. (*see Nicholls*, cols. 21-22). Therefore, even assuming that *Nicholls*, at some point, populates a "DIMWT" I/O Token, the single "DIMWT" I/O Token entry in Table II of *Nicholls* appears to indicate that there would be only a single "DIMWT" I/O Token entry, as compared to an entry "for each respective carrier of a plurality of carriers" as recited, *e.g.*, by Claim 1.

Yet further, even assuming that *Nicholls*, at some point, populates a "DIMWT" I/O Token, there is no disclosure, teaching or suggestion that *Nicholls* would do so "... in response to [a] first input [comprising a first set of parcel specifications for a first parcel]..." as recited, e.g., by Claim 1. Rather, it is respectfully submitted that other entries in Table II of *Nicholls*, such as, for example, the I/O Token entry labeled "TRACKNBR" following the "DIMWT" entry (described as "tracking number/COD tracking"), and the I/O Token entry named "CODRETTRK" that follows the "TRACKNBR" entry (described as "COD return tracking number"), indicate post-shipment carrier-supplied fields, not pre-shipment calculations or determinations provided in response to an input of parcel specifications.

For reasons similar to those described above with respect to the above-recited limitations of Claim 1 (and similarly with respect to Claims 74 and 78 which are dependent on Claim 1), it is respectfully asserted that *Nicholls* does not disclose, anticipate, teach or suggest the below-recited limitations of, *e.g.*, independent Claims 2 and 3 (and similarly with respect to Claims 4-7 which are dependent on Claim 3, and Claims 79 and 83 which are dependent on Claim 1):

> ... calculate, for each respective carrier of a plurality of carriers, a respective carrier-specific dimensional weight of the first parcel according to the first set of parcel specifications for the first parcel, according to a respective set of dimensional weight calculations rules for the respective carrier, and according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel ...

With respect to the rejection of Claim 58, Claim 58 recites "... in response to the first input, for a first carrier of a plurality of carriers: ...calculating a first carrier-specific dimensional weight according to a first set of carrier-specific dimensional weight calculation rules, in view of the first set of physical specifications about the first parcel...". The first input, according to Claim 58, comprises "... a first set of parcel specifications for a first parcel to be shipped by a

first user, wherein the first set of parcel specifications comprises a first set of physical specifications about the first parcel ...".

As compared to the above-cited limitations of Claim 58 (and similarly with respect to Claims 59-62, 66, and 70-73 which are, in one way or another dependent on Claim 58), *Nicholls* discloses that either "...the service is selected [by the user] from the Service box ..." or that "...the service may be set to Best Way and the system will choose the least cost carrier which meets the transit time requirements indicated in the commitment field ...". *See Nicholls*, Col 7, lines 53-60; see also, *e.g.*, FIG. 4A of *Nicholls*. Even assuming that *Nicholls* populates a "DIMWT" I/O Token, in view of the above-recited disclosure of *Nicholls*, it is therefore respectfully submitted that *Nicholls* does not disclose calculating a dimensional weight "... in response to an input of the physical specifications of a parcel ...", but rather, requires the input of a selection by the user of a carrier.

Further, it is respectfully submitted that combining *Kara* with *Nicholls* still does not disclose, anticipate, teach or suggest, the following limitations recited, *e.g.*, by Claim 4 on which Claim 7 ultimately depends:

> ... for each respective delivery service of a plurality of delivery services offered by each respective supporting carrier, calculate a respective service-specific, carrier-specific shipping rate for shipping the first parcel ...

As compared to the above-cited limitations of, *e.g.*, Claim 4 on which rejected Claim 7 ultimately depends, *Nicholls* discloses that either "...the service is selected [by the user] from the Service box ..." or that "...the service may be set to Best Way and the system will choose the least cost carrier which meets the transit time requirements indicated in the commitment field ...". *See Nicholls*, Col 7, lines 53-60; *see also, e.g.*, FIG. 4A of *Nicholls*.

Similarly, it is respectfully submitted that *Kara* discloses a user pre-selection of a particular delivery service and a subsequent display of carrier-specific rates for the pre-selected delivery service adjacent to an identifier of the respective carrier. *See, e.g.*, *Kara*, Figure 8A; *Kara*, col. 5, lines 56 – col. 6, line 6; *Kara*, col. 22, lines 21-48 (disclosing a "... program [that] automatically calculates the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters* ..." *Kara*, col. 22, lines 39 – 42 (emphasis added)). Therefore, combining *Kara* with *Nicholls* still does not disclose,

anticipate, teach or suggest, the above-cited limitations recited, *e.g.*, by Claim 4 on which Claim 7 ultimately depends.

Yet further, it is respectfully submitted that combining *Barns-Slavin* with *Nicholls* still does not disclose, anticipate, teach or suggest, the above-cited limitations of Claims 3 and 4 on which Claim 6 ultimately depends, because, similar to *Kara*, *Barns-Slavin* discloses a pre-selection of a carrier. *See, e.g.*, *Barns-Slavin*, col. 1, lines 8-10 ("... carrier management system for enabling a user to determine the shipping charges for shipping of parcels by a *selected* carrier." (emphasis added)).

Still further, it is respectfully submitted that combining *Nicholls* with *Jensen* does not compensate for the absent disclosures of *Nicholls*. *Jensen* is directed to "an integrated measuring system on a conveyor belt system capable of electronically acquiring information about a package's dimensions ..." and "... the actual package weight ..." for "... transmitting ... to electronic data processing units for calculation of the packages dimensional volume for use in other calculations such as determination of its freight cost ...". *Jensen*, col. 2, lines 20 - 31. It is respectfully submitted that there is no disclosure in *Jensen* that *Jensen*, or the system(s) to which *Jensen* transmits, "... appl[ies] a respective set of carrier-specific dimensional weight calculation rules, *for each respective carrier of a plurality of carriers*, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight ..." as recited, *e.g.*, in Claim 1 (emphasis added).

B. ***CONCLUSION***

For the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,
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